TRANSCRIPT OF RECORD

SUPREME COURT OF THE UNITED STATES

OCTOBER TERM, 1916.

No. 952.

THE UNITED STATES EX RELATIONE CHARLES STEINMETZ, PLAINTIFF IN ERROR,

vs.

FREDERICK I. ALLEN, COMMISSIONER OF PATENTS.

IN ERROR TO THE COURT OF APPEALS OF THE DISTRICT OF COLUMBIA.

(28,954.)

(19,034.)

SUPREME COURT OF THE UNITED STATES.

OCTOBER TERM, 1903.

No. 383.

THE UNITED STATES *EX RELATIONE* CHARLES P. STEINMETZ, PLAINTIFF IN ERROR,

vs.

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1 In the Court of Appeals of the District of Columbia.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents } No. 1272.

Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, Petitioner, *vs.* FREDERICK I. ALLEN, Commissioner of Patents, Respondent. } No. 45620. At Law.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

Be it remembered, that in the supreme court of the District of Columbia, at the city of Washington, in said District, at the times hereinafter mentioned, the following papers were filed and proceedings had, in the above entitled cause, to wit:—

Petition for Mandamus.

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

To the supreme court of the District of Columbia:

Your petitioner, Charles P. Steinmetz, respectfully represents:

1. That he is a citizen of the United States and resides at Schenectady, in the county of Schenectady, and State of New York:

2. That prior to the 21st day of November, 1896, he was the true, original and first inventor and discoverer of certain new and useful improvements in motor meters, not known or used by others in this country and not patented or described in any printed publi-

2 cation in this or any foreign country before his invention or discovery thereof, and not in public use or on sale in this country for more than two years prior to his hereinafter-mentioned ap-

plication for letters patent therefor; and so being the true, original and first inventor thereof, he, on the said 21st day of November, 1896, filed in the United States Patent Office an application for letters patent of the United States for said invention.

3. That said application was made, by your petitioner, in writing and addressed to the Commissioner of Patents, in due form, as required by the statutes of the United States, and by the rules of practice in the United States Patent Office in such case made and provided and with said application was filed by your petitioner a written description of his said invention, and of the manner and process of making, constructing, practicing and using the same, in such full, clear, concise and exact terms as to enable any person skilled in the art or science to which said invention appertains or with which it is most closely connected, to make, construct, practice and use the same; and in such written description the principle of your petitioner's said invention and the best mode in which your petitioner contemplated applying the same were explained; and your petitioner particularly pointed out and distinctly claimed in his said application the parts, improvements, combinations and methods which he claimed as his invention; and the specification and claims of said application were signed by your petitioner and attested by two witnesses;

4. That your petitioner did further furnish with said application drawings of his said invention, signed by his attorney and attested by two witnesses;

5. That your petitioner did further make oath before a proper officer, according to law, that he verily believed himself to be the original and first and sole inventor and discoverer of the said invention for which he solicited a patent, that he did not know and did not believe that the same was ever known or used, and did state of what country he was a citizen;

6. That your petitioner at the time of the filing of his said application did pay to the said Commissioner of Patents $15, the fee required by law and did in all other respects fully comply with the statutes of the United States and with the rules of practice in the United States Patent Office in such cases made and provided and that the said application became known and designated as application serial No. 612,943.

7. That said application contained and contains the following claims of invention to which your petitioner believes himself entitled, viz:

1. The herein-described method of measuring alternating electric currents, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature in a motor meter arranged within the energizing coils producing said lines of magnetization.

3 2. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or

axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

3. The herein-described method of actuating a single-phase alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism from three intersecting lines or axes of magnetization and adapted to actuate a rotatable armature arranged within the energizing coils producing said lines of magnetization.

4. The herein-described method of actuating an alternating-current motor meter, which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines and subjecting an armature to the inductive action of said field.

5. The herein-described method of actuating an alternating-current motor-meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, and subjecting an armature to the inductive action of said field.

6. The herein-described method of actuating an alternating-current motor meter which consists in setting up or establishing a shifting field of magnetism by means of magneto-motive forces acting along three intersecting lines, one magneto-motive force being proportional to the current and the other two to the electro-motive force, the several magneto-motive forces being so proportioned and related to each other than the resultant of the last two is displaced in phase from the first by the complement of the angle of lag, and subjecting an armature to the inductive action of said field.

7. In a watt meter for alternating electric currents, means for producing a magnetic flux proportional to the current and varying in phase therewith, means for producing a second magnetic flux proportional to the electro-motive force and lagging in phase behind the same, and means for producing an auxiliary flux along a line at an angle to said second flux and of such magnitude and phase that the resultant of the two last-mentioned fluxes will lag behind the first by the complement of the angle of lag.

8. The combination in an electro motor of a field-magnet system and means for inducing therein magnetic fluxes of three phases, one a flux due to a series coil and proportional to the current, a second flux due to a shunt potential coil and lagging behind the electro-motive force and a third flux lagging behind said second flux and having a fixed angular relation thereto such that the resultant of the second and third fluxes is dephased by substantially the complement of the angle of lag from the flux due to the series coil.

9. The combination in a recording electric meter of a field-magnet system acting on the armature and having a plurality of intersecting magnetic axes, means for inducing along one of said
4 magnetic axes a flux proportional to the current and varying in phase therewith, and means for inducing along the other

magnetic axes a plurality of other fluxes dependent upon the potential of the metered circuit, which lag behind the electro-motive force by different amounts and act upon the armature at different points said fluxes being so proportioned in value and phase that their joint action upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially affected by changes of phase relation.

10. In a watt meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motice force and lagging behind the same and means for producing along the third axis an auxiliary magnetic flux also proportional to the electro-motive force, of such a magnitude and phase that the joint action of the several fluxes upon the armature will enable the meter to register the true energy consumed in an alternating-current circuit without being substantially effected by changes of phase relation.

11. In a meter for alternating currents, the combination of a field-magnet system having three intersecting magnetic axes, means for producing along one of said axes a magnetic flux proportional to the current and varying in phase therewith, means for producing along another of said axes an alternating flux proportional to the electro-motive force and lagging behind the same, and means for producing along the third axes an auxiliary magnetic flux also proportional to the electro-motive force and of such magnitude and phase that the joint action of the two potential fluxes upon the armature will produce a torque sufficient to overcome the static friction of the meter.

12. In a single-phase alternating current meter, the combination of a field-magnet system having three intersecting magnetic axes, a field coil in which the current phase varies as the conditions of the circuit change, producing a magnetization along one magnetic axis, a potential coil producing a magnetization along another magnetic axis, a reactance device in series with said potential coil for lagging the current behind the electro-motive force and a second potential coil depending for its current upon the first potential coil, producing a magnetization along the third magnetic axis; the two potential coils conveying currents which differ in phase from each other, and each generating a flux which acts upon the armature at a point removed from the point at which the flux due to the other potential coil acts upon the armature.

13. In an electric meter, the combination of a multipolar field-magnet structure having three magnetic axes, current coils mounted upon some of the field poles and producing a magnetization along one of said magnetic axes, potential coils mounted upon other field poles and producing a magnetization along another one of said magnetic axes, and other potential coils mounted upon a portion only of the last-named field poles, or some of them,

and producing a magnetization along the third magnetic axes and an armature acted upon by the flux induced by the field coils.

8. That on or about the 15th day of May, 1900, the primary examiner to whom, according to law, your petitioner's said application was referred by the Commissioner of Patents for examination, examined and considered said application and decided that your petitioner must cancel from said application his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13, the same being all claims for the apparatus part of your petitioner's said invention and notified your petitioner of such decision.

9. That, after receiving the notice of said decision your petitioner persisted in his said claims in said application without altering his specification in any way and his said application was thereupon, by the primary examiner, reconsidered and his aforesaid claims numbered 7, 8, 9, 10, 11, 12 and 13 were, on or about the 31st day of July, 1900, a second time required to be canceled from said application;

10. That on, or about the 4th day of August, 1900, your petitioner regarding the last-mentioned decision a second final rejection and refusal of his said claims Nos. 7, 8, 9, 10, 11, 12 and 13, by the primary examiner, and feeling aggrieved thereby, appealed therefrom, by written petition, to the board of examiners-in-chief, in accordance with the statute in such case made and provided and with the rules of practice in the United States Patent Office regulating such appeals, and paid to the Commissioner of Patents the statutory fee of $10, required for such appeal.

11. That on or about the 9th day of August, 1900, the primary examiner, contrary to his duty, refused to answer said appeal and to forward the said appeal with his answer thereto and the statement required by the rules of practice in the United States Patent Office, to the said board of examiners-in-chief, and on or about the 16th day of August, 1900, upon your petitioner's request for a reconsideration of said action repeated his said last-mentioned decision and refusal;

12. That on or about the 20th day of August, 1900, your petitioner petitioned the Commissioner of Patents to direct the said primary examiner to answer and forward said appeal, which petition was, on or about the 28th day of September, 1900, denied;

13. That, thereafter, to wit, on or about the 16th day of January, 1902, your petitioner petitioned the present Commissioner of Patents, the said Frederick I. Allen, to direct the said primary examiner to answer said appeal, and to forward said appeal with his said answer thereto and with the statement required by the rules of practice of the U. S. Patent Office to the said board of examiners-in-chief for the determination of said board, which petition was on the 7th day of February, 1902, denied.

14. That your petitioner is advised and believes that the
6 said decision of the primary examiner of the 31st day of July, 1900, repeating his previous decision of the 15th day of May, 1900, requiring the cancellation from your petitioner's said

application of all claims covering the apparatus part of his said invention, namely, his aforesaid claims 7, 8, 9, 10, 11, 12 and 13, constituted and constitutes, in fact and in law, an adverse decision upon the merits of your petitioner's aforesaid application and was and is a second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13 of said application and that he is entitled, as a matter of right, under the statutes of the United States in such case made and provided, to an appeal from said adverse decision and second rejection of said claims by said primary examiner to the said board of examiners-in-chief and is entitled, as a matter of right, to have the validity of said adverse decision and second rejection revised and determined by the said board of examiners-in-chief;

15. That, under the rules of practice of the United States Patent Office, it became and was the duty of the said primary examiner to, within five days of the filing of your petitioner's aforesaid appeal, answer such appeal by furnishing the board of examiners-in-chief with a written statement of the grounds of his decision on all the points involved in the appeal and to forward such answer and statement with such appeal, to the said board of examiners-in-chief, for the revision and determination by said board of such appeal;

16. That upon the refusal of the primary examiner to furnish such answer and statement and to forward the same to the said board of examiners-in-chief as aforesaid, it became and was the duty of the said Frederick I. Allen, Commissioner of Patents to direct the said primary examiner to furnish said answer and statement and forward the same with such appeal to the board of examiners-in-chief, and the failure and refusal of the said Frederick I. Allen, Commissioner of Patents, when so requested by your petitioner as aforesaid, to perform said duty and to make such direction rendered and renders it impossible for your petitioner to have the validity of the said second rejection and refusal by the said primary examiner of the aforesaid claims Nos. 7, 8, 9, 10, 11, 12 and 13, of his said application, revised and determined by the said board of examiners-in-chief and in turn, if necessary, by the other duly constituted statutory tribunals of higher authority and operates to the great wrong and injury of your petitioner in the premises;

17. That, well hoping that the said board of examiners-in-chief might take jurisdiction of his said appeal and revise and determine the same, even without an answer or statement from the primary examiner in regard thereto and notwithstanding the action of the said Frederick I. Allen, Commissioner of Patents, aforesaid, your petitioner on the 28th day of February, 1902, petitioned the said board of examiners-in-chief, praying that said board of examiners-in-chief take jurisdiction of said appeal and revise and determine the same and reverse the aforesaid adverse decision of the said primary examiner but said petition was, on the 6th day of
7 March, 1902, denied by said board of examiners-in-chief on the ground that said board could not revise and determine said appeal without the said primary examiner's answer and state-

ment, and further, in view of the decision of the said Frederick I. Allen, Commissioner of Patents, in the premises;

18. That by the refusal of the said Frederick I. Allen, Commissioner of Patents, to so direct the said primary examiner to furnish his said answer and statement and to forward the same with petitioner's said appeal to the board of examiners-in-chief, as requested, your peitioner was and is deprived of a legal right vested in him by the laws of the United States relating to the granting of letters patent for inventions and is entirely without redress or remedy in the premises, unless this honorable court by writ of mandamus shall interpose in his behalf.

Wherefore your petitioner prays that a writ of mandamus may be issued by this honorable court to the said Frederick I. Allen, Commissioner of Patents, commanding him to direct the primary examiner to forward your petitioner's said appeal to the board of examiners-in-chief with his proper answer and statement required by the rules of practice of the United States Patent Office, to the end that the aforesaid adverse decision of the primary examiner and the aforesaid second rejection of the said claims 7, 8, 9, 10, 11, 12 and 13, of your petitioner's said application by said primary examiner, complained of, may, by said board of examiners-in-chief, be revised and determined according to law, and that speedy justice may be done your petitioner in the premises. And as in duty bound your petitioner will ever pray, etc.

CHARLES P. STEINMETZ.

O K.
A. S. D.

CHURCH & CHURCH, *Attorneys.*
ALBERT G. DAVIS, *Of Counsel.*

STATE OF NEW YORK, }
County of Schenectady, } ss:

Charles P. Steinmetz, being duly sworn deposes and says that he has read the foregoing petition by him signed and knows the contents thereof; that the statements therein contained are true of his own knowledge, except as to those matters therein stated to be on information and belief and as to such matters he verily believes it to be true.

CHARLES P. STEINMETZ.

Subscribed and sworn to before me this 28th day of August, 1902.

BENJAMIN B. HULL,
[SEAL.] *Notary Public, Schenectady County, N. Y.*

8 *Rule to Show Cause.*

Filed September 9, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ, Petitioner, *vs.* FREDERICK I. ALLEN, Commissioner of Patents, Respondent. } At Law. No. 45620.

Upon consideration of the petition for mandamus in the above-entitled cause, it is ordered, on this 9th day of September, 1902, that the respondent herein show cause, on the 17th day of September, 1902, at 10 o'clock a. m., before me at the special term of the court, why a writ of mandamus should not issue, as prayed in said petition; provided a copy of this order and of said petition be served upon the respondent on or before the 17th day of September, 1902.

JOB BARNARD,
Associate Justice of the Supreme Court of the District of Columbia.

Return of Respondent.

Filed September 17, 1902.

In the Supreme Court of the District of Columbia.

THE UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

To the honorable the justices of the supreme court of the District of Columbia:

The return of the respondent to the rule to show cause issued herein upon the 9th day of September, 1902.

The said Frederick I. Allen, Commissioner of Patents, comes and for answer to the order to show cause why the said writ of mandamus should not issue says, upon information and belief:

1. The respondent admits the allegations of the first paragraph of the petition.

2. The respondent admits the allegations of the second paragraph of the petition.

3. As to the third paragraph of the petition, the respondent denies that the application was in due form as required by the stat-
9 utes and rules of practice, since it included claims to an apparatus and claims to a process. The respondent admits that in other respects the application was in proper form.

4. The respondent admits the allegations of the fourth paragraph of the petition.

5. The respondent admits the allegations of the fifth paragraph of the petition.

6. As to the sixth paragraph of the petition, the respondent denies that the application fully complied with the statutes and rules of practice, since it included claims to an apparatus and claims to a process.

7. The respondent admits the allegations of the seventh paragraph of the petition.

8. As to the eighth paragraph of the petition, the respondent admits that the examiner having charge of the relator's application wrote a letter to him on May 15, 1900, saying:

"In accordance with office letter of January 2, 1900, applicant is required to cancel from this case all claims except those for the method."

In further explanation of this matter, the respondent says that prior to May 15, 1900, and on October 9, 1899, the primary examiner wrote a letter to the relator, requiring division between the process claims and the apparatus claims, in accordance with rule 41, before further action would be given upon the merits of the case. In a reply filed December 15, 1899, the respondent asked that his process claims be placed in interference with the claims of a patent granted to one Duncan, and said:

"It is therefore requested that the retirement for division be waived for the present in order that an interference with the patent to Duncan above referred to may be declared."

The examiner then wrote a letter on January 2, 1900, saying:

"Pending the determination of the interference applicant may retain the method and apparatus claims in this case, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims in this application will not be permitted."

The relator's reply, filed January 19, 1900, was:

"It is respectfully requested that the interference with the Duncan patent, No. 604,464, be declared as soon as possible."

The interference was thereupon declared on February 7, 1900, and the decision therein was in favor of the relator and against Duncan. After that decision the examiner wrote the said letter of May 15, 1900.

By his request for the interference in reply to the examiner's warning as to the effect of such request, the relator eliminated from consideration the question which of the two inventions claimed would be retained in this case if division was finally insisted upon,

and he is estopped from denying that the apparatus, if either,
10 must be presented in a separate application. His action in accepting the ruling of the office upon the question of election, and thereby obtaining the interference, left open for final decision only the question whether division should be required, and it was upon this question that the examiner ruled in his letter of May 15, 1900.

9. As to the ninth paragraph of the petition, it is admitted that the relator filed a letter on July 16, 1900, asking for a reconsideration of the examiner's action, and that the examiner thereupon repeated his action.

10. The respondent admits that the relator filed an appeal and paid the fee, but denies that the statute and rules of practice provide for such appeal, as alleged in the tenth paragraph of the petition herein.

11. The respondent admits that the primary examiner refused to answer and forward the appeal, as alleged in the eleventh paragraph of the petition.

12. The respondent admits the allegations of the twelfth paragraph of the petition; a copy of the decision denying the petition is hereto attached, as Exhibit A.

13. The respondent admits the allegations of the thirteenth paragraph of the petition and attaches hereto and as a part hereof a copy of his decision dated February 7, 1902, marked Exhibit B.

The respondent further alleges that before the date of the said petition and decision, the relator had under the provision of rule 145 petitioned the respondent as Commissioner of Patents to review and reverse the action of the primary examiner requiring division, and after a full consideration of the matter the respondent was of the opinion that the requirement for division was proper and for that reason denied the petition on January 2, 1902.

14. The respondent denies that the examiner's letter of July 31, 1900, was a second rejection of claims made by the relator, and denies that the relator has the right of appeal therefrom to the examiners-in-chief. The examiner's action was merely a ruling that the relator should present in two applications, in accordance with the provisions of rule 41, approved by the Secretary of the Interior, the two inventions now claimed in one application, and did not involve the rejection of any claim or an action upon the merits of any claim made by the relator. The statutes and rule 133 of the rules of practice do not provide for an appeal to the examiners-in-chief from an examiner's requirement for division, and the examiners-in-chief have no jurisdiction to pass upon the question whether or not division should be required.

15. The respondent denies that it was the duty of the primary examiner to forward the appeal and to furnish a statement of the grounds of his action, as alleged in the fifteenth paragraph of the petition herein.

16. The respondent denies that it was his dnty to direct the primary examiner to forward the appeal, for the reason that no

authorized appeal had been filed, as alleged in the sixteenth paragraph of the petition herein.

11 17. The respondent admits the allegations of the seventeenth paragraph of the petition.

18. The respondent denies that the relator has by the action of the respondent been deprived of any legal right vested in him by the laws of the United States, as alleged in the eighteenth paragraph of the petition herein.

The respondent further says that by reason of the facts hereinbefore alleged, he should be dismissed with his reasonable costs.

FREDERICK I. ALLEN.

JOHN M. COIT, *Attorney.*

DISTRICT OF COLUMBIA, *ss:*

On this day personally appeared before me, a notary public in and for the said District of Columbia, Frederick I. Allen, and made oath that he is the respondent in the above-entitled cause; that he has read the foregoing answer by him subscribed and knows the contents thereof; that the same is true of his own knowledge, except as to the matters therein stated to be alleged on information and belief, and that as to those matters he believes it to be true.

FREDERICK I. ALLEN.

Given under my hand this 13th day of September, 1902.

A. M. BUNN,

[SEAL.] *Notary Public for the District of Columbia.*

EXHIBIT A.

Filed September 17, 1902.

Where applicant does not care to comply with the examiner's requirements in a matter of division such as is here involved, it has been the practice for the past thirty years to treat the question not as one of merits and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice. The petition is denied.

WALTER H. CHAMBERLIN,
Assistant Commissioner.

September 28, 1900.

12

Exhibit B.

Filed September 17, 1902.

Jan. 22, 1902. M. H.

United States Patent Office.

Ex Parte Charles P. Steinmetz.

Motor meters.

Petition.

Application filed November 21, 1896; No. 612,943.

Mr. Albert G. Davis for applicant.

This is a petition from the action of the primary examiner refusing to forward to the examiners-in-chief an appeal in the above-entitled case.

The examiner required division in this application between claims to the apparatus and claims to the process, and this action was clearly correct under the express provisions of rule 41. The applicant then asked for an interference with a patent containing the process claims, and that interference was declared, the applicant being informed that the request for an interference upon the process was considered an election to retain the process claims in this case, and that after the conclusion of the interference he would be required to cancel from the case the apparatus claims. The interference was decided in favor of this applicant and the examiner then insisted upon his requirement that the application be divided and that the apparatus claims be canceled. The petitioner states that this action amounted to a refusal of the apparatus claims, and therefore took an appeal to the examiners-in-chief. The examiner refused to forward the appeal, upon the ground that the questions involved are petitionable to the Commissioner and are not appealable to the examiners-in-chief.

The requirement for division is clearly a matter of form, not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief, and although

it is a general rule of law that the appellate tribunal is the
13 one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon that question in the first instance.

The petition is denied.

F. I. ALLEN,
Commissioner.

February 7, 1902.

Motion for Judgment, &c.

Filed September 25, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

And now comes the relator, by Church & Church, his attorneys, and moves the court for judgment for a peremptory writ of mandamus against the respondent, notwithstanding the return of the respondent herein.

CHURCH & CHURCH,
Attorneys for Relator.

Opinion of the Court.

Filed December 2, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents. } No. 45620. Law.

This proceeding is instituted for the purpose of obtaining a mandamus against the Commissioner of Patents to require him to direct the primary examiner to forward to the board of examiners-in-chief an appeal which the relator has asked in a matter pending in the

Patent Office, wherein he has applied for a patent for certain new and useful improvements in motor meters.

14 In his said application, being serial No. 612,943, thirteen claims are stated in separate paragraphs. The primary examiner decided that the seven claims numbered 7 to 13 should be cancelled, or stricken from the application, and only the six claims first named should be considered. This ruling is based upon the contention of the examiner that the said several groups of claims are not properly related to each other, or to the alleged invention, so as to entitle them to be covered by a single patent, if one should be allowed; and for that reason, it is held that only one group should be considered in a single application; and that if the other group is to be considered at all, it must be in a separate application, thus making two cases instead of one. The relator contends that all the claims are properly united in a single application, and should be so considered; and if patentable, that a single patent should be issued covering all of them; and that it would be unlawful to grant two patents for a single invention; and if granted, the last one would be invalid.

From this ruling of the primary examiner requiring the cancellation of the seven claims last stated in the application, which it is contended has been twice made, the relator asked an appeal to the board of examiners-in-chief; but the same was denied. He then applied to the Commissioner to direct such appeal, but was answered, that the requirement for division was clearly a matter for form, not involving the merits of the claims; and that in such a matter, no appeal to the examiners-in-chief would lie.

He then applied to the board of examiners-in-chief to hear said appeal, but they declined to hear the same, because the primary examiner had not forwarded the necessary papers, and because the Commissioner had refused, on petition, to require such appeal to be forwarded to them by the said primary examiner.

The application is therefore made to this court for a mandamus in the premises, on the theory that the petitioner has a statutory right to such appeal; and that there is no discretion in the Commissioner to refuse it.

The claims, which the examiner required should be divided, were alleged, to be claims pertaining to the apparatus, and claims pertaining to the process, and the power to require such division is said to be conferred by rule 41 of the Patent Office rules. That rule provides that "claims for a machine, and the process in the performance of which the machine is used, must be presented in separate applications." Rule 42 provides, that "if several inventions, claimed in a single application, be of such a nature that a single patent may not be issued to cover them," the inventor will be required to elect as to which he will prosecute; and the others may be made the subjects of separate applications.

The Commissioner of Patents is authorized to establish regulations, not inconsistent with law, and subject to the approval of the

Secretary of the Interior, "for the conduct of proceedings in the Patent Office." Sec. 483, R. S. U. S.

Section 4909 R. S. U. S. provides that every applicant for a
15 patent, "any of the claims of which have been twice rejected," may have his appeal from the primary examiner to the board of examiners-in-chief.

For the conduct of proceedings in appeal under this statute, the Commissioner has adopted certain regulations, appearing in rules number 133 and 134. By these it is provided, that every applicant for a patent any of whose claims "have been twice rejected *for the same reasons, upon grounds involving the merits of the invention,* * * * may, upon payment of a fee of $10 appeal from the decision of the primary examiner," &c. and "all the claims must have been passed upon and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before the case can be appealed," &c.

Are these regulations consistent with law, and do they reasonably and fairly pertain to the conduct of proceedings in the Patent Office? If so, the mandamus prayed for in this case should be denied; but if not, and the relator shows himself entitled to his appeal under the statute, and has no other remedy in the premises, then the mandamus ought to be granted.

In a case clearly involving two separate inventions, it would seem proper that the claims referring to each should be divided and presented in two applications instead of in one; and that such requirement is properly a matter of practice or procedure, to be regulated by the Commissioner in the interest of all parties having business with the office. The hardship, if any, would appear to be in those cases where there may be doubt as to the claims describing two inventions. So that the applicant may not suffer an injustice in such preliminary matter, in case the primary examiner decides against him, the Commissioner has adopted rule 145, which provides for an appeal directly to the Commissioner, by petition, without fee.

It is contended by counsel for petitioner, that the statute contemplates an appeal in such formal, or preliminary matter, to the board of examiners-in-chief, and thence to the Commissioner, and finally to the Court of Appeals of the District of Columbia, the same as if the patentability of the claims was in question, rather than the manner of their presentation to the office.

In this case the examination as to the alleged new invention or discovery, required by sec. 4893 R. S. U. S., has not been made, and the questions as to its novelty, usefulness or importance, or the right of the applicant to have a patent, have not been decided; and therefore it is contended that the claims have not been rejected, within the meaning of said section 4909 granting the right of appeal.

What the relator alleges to be error, and for which he desires the appeal, is only a matter of practice or precedure, the very thing that the Commissioner is empowered to regulate by established rules. It is a question of pleading, or of description of alleged invention, and in no way involves the novelty, or usefulness of the

same, and therefore deprives the applicant of no substantial right, *provided* the claims ordered cancelled can be properly considered in a separate application.

16 It is urged by counsel for the relator that if the invention described in the several paragraphs of the application, is in fact one, then the requirement that the several claims constituting the proper description of it shall be divided, and two applications filed for the one invention, will be a denial, of justice, because the grant of a patent for one part of a unit would preclude the grant of a patent for the second part; or, if granted, the second patent would be invalid.

Although the compulsory division of claims pertaining to a single invention may be a serious matter for the inventor, it is still interlocutory, and it does not seem to be one that can be remedied by a proceeding in mandamus, for it is a technical question peculiarly within the jurisdiction of the Commissioner of Patents, and requires judgment on his part to decide. If wrong in his conclusion, he cannot be set right by mandamus. The decisions on such interlocutory questions of practice, are seldom appealable under any of the judicial systems of our country. If appeals were intended, in the executive departments of the Governments, from rulings involving only the method of doing things, or the form in which claims should be stated, or other preliminary or interlocutory orders or decisions, they should be provided for expressly, and not left to be raised by implication.

As to whether the primary examiner has committed an error in this matter, or whether the relator is correct in his contention that all his claims are properly united in one application, is not important in this proceeding, and hence no opinion is expressed on that question. The question presented here is as to the right of appeal, not as to the merits of the decisions to be appealed from. The result to the claimant of an erroneous judgment by the primary examiner in requiring a division of the claims in an application, is not necessarily the loss of his right to a patent. In most cases perhaps it is only an increase of the cost of obtaining the patent; and the question of costs is one that is seldom considered on an appeal.

In my opinion the statute authorizing an appeal, when claims have been twice rejected, means that the claims must have been considered on their merits, and found to be not patentable; and therefore that nothing inconsistent with this law is found in rules 133 and 134, regulating the procedure in appeals, so far as the same relates to a case like this.

That a decision on the merits must first be had before an appeal can be taken to the board of examiners-in-chief would seem to be as necessary as it would be to the right of the applicant to file a bill in equity under sec. 4915 R. S. U. S., and the Supreme Court holds it to be indispensable in that case. Butterworth *v.* U. S. *ex rel.* Hoe, 112 U. S. 50.

For these reasons, and without further considering the question of the discretion of the Commissioner, or the question of estoppel

argued in this case, I think the relator has not shown himself entitled to the appeal prayed for under the law, and that the writ of mandamus must be denied.

JOB BARNARD, *Justice.*

17 *Final Judgment.*

Filed December 19, 1902.

In the Supreme Court of the District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. STEINMETZ *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } At Law. No. 45620.

This cause coming on to be heard upon the relator's petition for a writ of mandamus against the respondant, the rule to show cause, the return and the motion of the relator for a peremptory writ of mandamus notwithstanding the return, and having been argued by counsel for the respective parties and considered by the court, it is by the court this 19th day of December, 1902, ordered and adjudged that the rule to show cause is hereby discharged and that the relator's petition be, and the same is hereby, dismissed at the costs of the relator. The relator having prayed an appeal to the court of appeals of the District of Columbia from the judgment of this court dismissing his petition, such appeal is hereby allowed, and the bond is fixed in the penalty of two hundred and fifty dollars.

JOB BARNARD, *Justice.*

Approved as to form:
JOHN M. COIT,
Attorney for Respondent.

Memorandum.

December 19, 1902.—Appeal bond filed.

Supreme Court of the District of Columbia.

UNITED STATES OF AMERICA, *District of Columbia,* } *ss:*

I, John R. Young, clerk of the supreme court of the District of Columbia, hereby certify the foregoing pages, numbered from 1 to 31, inclusive, to be a true and correct transcript of the record, as per rule 5 of the Court of Appeals of the District of Columbia, in cause No. 45,620, at law, wherein The United States *ex rel.* Charles P.

Steinmetz is petitioner, and Frederick I. Allen, Commissioner of Patents, is respondent, as the same remains upon the files and
18 of record in said court.

In testimony whereof, I hereunto subscribe my name and affix the seal of said court, at the city of Washington, in said District, this 9th day of January, A. D. 1903.

Seal Supreme Court of the District of Columbia.

JOHN R. YOUNG, *Clerk.*

Endorsed on cover: District of Columbia supreme court. No. 1272. United States *ex relatione* Charles P. Steinmetz, appellant, *vs.* Frederick I. Allen, Commissioner of Patents. Court of Appeals, District of Columbia. Filed Jan. 13, 1903. Robert Willett, clerk.

19 THURSDAY, *April 9th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The argument in the above entitled cause was commenced by Mr. Melville Church attorney for the appellant, and was continued by Mr. John M. Coit attorney for the appellee.

TUESDAY, *April 14th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The argument in the above entitled cause was continued by Mr. John M. Coit attorney for the appellee, and was concluded by Mr. Albert G. Davis, attorney for the appellant.

20 UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

(Mr. Chief Justice ALVEY delivered the opinion of the court:)

This appeal is from a judgment of the supreme court of this District dismissing the petition of the appellant for a writ of mandamus against the Commissioner of Patents, requiring him to direct the primary examiner in the Patent Office to forward to the board of examiners-in-chief an appeal prayed for in the matter of the application for a patent pending in said office, relating to improvements in motor meters.

It is shown by the petition, and answer to the rule passed thereon, that on the 21st day of November, 1896, the appellant filed in the Patent Office an application for a patent for his invention of new and useful improvements in motor meters. This application contained, and still contains, thirteen claims that relate to the alleged invention. Of these several claims 1 to 6, inclusive, are directed to the novel method or process involved in the working of the invention; and claims 7 to 13, inclusive, are directed to the novel means or apparatus by which such method is carried into practice.

This application was in charge of a primary examiner of the office for examination, and on the 9th day of October, 1899, this primary examiner wrote to the appellant in regard to his application, requiring division under rule 41 of the office, between the process claims and the apparatus claims, before further action would be taken in respect to the merits of the claims. On December 15, 1899, the appellant asked that his process claims be placed in interference with claims in a patent issued to one Duncan. In his letter the appellant said: "It is therefore requested that the requirement for division be waived for the present, in order that an inter-
21 ference with the patent to Duncan above referred to may be declared."

In reply to this request of the appellant, the examiner informed the appellant, by letter of January 2d, 1900, that "pending the determination of the interference, applicant may retain the method and apparatus claims *in the case*, but the acceptance of an interference on one of the method claims will be held by the office to be an election of the prosecution of the method claims, and further prosecution of the apparatus claims *in this application* will not be permitted."

To this letter of the examiner the appellant, by letter of January 19, 1900, replied, that "it is respectfully requested that the interference with the Duncan patent, No. 604,464, be declared as soon as possible."

The interference was thereupon declared February 7, 1900, and decision therein was in favor of the appellant and against Duncan. It was after that decision that the examiner wrote to the appellant the letter of May 15, 1900, in which he said: "In accordance with office letter of January 2, 1900, applicant is required to cancel *from this case* all claims except those for the method."

After this, that is to say, on July 16, 1900, the appellant asked for a reconsideration of this action of the office, but the examiner repeated the action, and refused to act upon the merits of the application until the division was made in accordance with the requirement.

The appellant, then, that is, on August 4, 1900, filed what purported to be an appeal to the examiners-in-chief from the alleged rejection of his apparatus claims. But this appeal the examiner refused to answer and forward, because, as he contended, no appeal in such state of case to the examiners-in-chief was authorized. Whereupon, on August 20, 1900, the appellant petitioned the Com-

missioner of Patents to direct the examiner to answer and forward the appeal, but this application was denied by the Assistant Commissioner, who, in his opinion said, that "it has been the
22 practice for the past thirty years to treat the question not as one of merits and appealable to the examiners-in-chief, but as a proper matter for petition to the Commissioner. I see no reason for overturning this practice." On the 10th day of January, 1902, a like petition was presented to the present Commissioner of Patents, the respondent herein, and on the 7th day of February, 1902, such petition was likewise denied. In the opinion of the Commissioner of Patents, denying this application, he said: "The requirement for division is clearly a matter of form, and not involving the merits of the claims, since the claims may be, and in the present case are, regarded as allowable. The examiner has not refused to grant a patent to this applicant upon any of the claims presented, but has merely required that they be included in two patents instead of one. It is a question of procedure or of the manner of securing the protection which is in controversy and not the right of the applicant to a patent upon any of the claims presented.

"The examiner was right in taking the position that the question involved is not appealable to the examiners-in-chief; and although it is a general rule of law that the appellate tribunal is the one to determine whether or not it has jurisdiction when an appeal is taken to it, it is not considered necessary in the office practice to follow that practice strictly, since the Commissioner is the head of the office and has the final decision upon all questions arising within it and may settle questions of this kind upon direct petition. The examiner's decision upon the question whether or not an appeal to the examiners-in-chief is regular and proper is not final, since it may be reviewed by the Commissioner upon petition, but he has authority to pass upon the question in the first instance."

The appellant regarding the action of the primary examiner as an adverse decision of his right to a patent, and as a rejection of his application, on the 28th day of February, 1902, applied by petition directly to the board of examiners-in-chief to take jurisdiction of
23 his appeal; but this petition was, on the 6th day of March, 1902, also denied, on the ground that the examiners-in-chief could not, under the rules of the Patent Office, revise and determine the validity of the action of the primary examiner, without the latter's answer to the appeal, and, further, because of the previous action of the Commissioner of Patents in the premises.

Upon these proceedings in the Patent Office, the appellant applied to the court below for a mandamus to the Commissioner of Patents, requiring the latter to order and direct the primary examiner to answer and forward the appellant's appeal to the examiners-in-chief, to the end that said examiners-in-chief may review the action of said primary examiner in the premises. A rule was laid and the Commissioner answered.

The respondent, The Commissioner of Patents, in answering the

petition for the writ, denied and controverted the ground upon which the writ was sought; and, in his answer, he referred to the provisions of the statute law upon the subject, and to the various rules of practice of the Patent Office, whereby he claims and insists that the proceedings in the Patent Office in all respects conformed to and were in strict compliance with the provisions of the statute law upon the subject, and with the rules of practice made in pursuance of the statute; and therefore, as he contends, there is no ground whatever for the issuance of the writ. The appellant moved for the writ, notwithstanding the matter contained in the answer; and the court, upon hearing, concurred in the views that prevailed in the Patent Office, and therefore denied the writ and dismissed the application therefor; and from which order the relator has appealed to this court.

It is incumbent upon the appellant, in a case like the present, to show clearly and affirmatively that there was not only a right of appeal, but that such right had been denied to the applicant under circumstances that entitle him to a mandamus to enforce the right. Or, as said by the Supreme Court of the United States, in *Ex parte Cutting*, 94 U. S. 14, 20, "To entitle the petitioners to the writ
24 asked for in this case, they must show that they have a clear right to an appeal which has been refused. The office of a *mandamus* is to compel the performance of a plain and positive duty. It is issued upon the application of one who has a clear right to demand such a performance, and who has no other adequate remedy. It is never granted in anticipation of an omission of duty, but only after actual default." This principle is laid down in many authorities, but is no where better summed up than in High in his work of Extraordinary Legal Remedies, in sect. 246, where the author says: "But to warrant the interference in this class of cases it must appear that the person seeking the relief is clearly entitled to an appeal, and when this does not appear, the writ will be refused. And mandamus will not lie to compel a court to settle a statement for the purpose of an appeal from a judgment which is only interlocutory and from which no appeal lies. Nor will the writ go to compel the allowance of an appeal from orders, the granting of which rests wholly within the discretion of the court."

The question then is, whether the right of appeal in this case is thus clearly shown to exist, and whether mandamus is the proper remedy for its refusal to the applicant. This question depends upon the proper construction of certain sections of the Revised Statutes of the United States and of certain rules of practice made to govern the course of proceeding in the Patent Office.

Section 4909, Revised Statutes United States, provides that—"Every applicant for a patent or for the reissue of a patent, any of the claims of which have been *twice rejected*, and ev-ry party to an interference, may appeal from the decision of the primary examiner, or of the examiner in charge of interferences in such case, to the board of examiners-in-chief; having once paid the fee for such appeal." And by section 4910, it is provided, that "If such

party is dissatisfied with the decision of the examiners-in-chief, he may, on payment of the fee prescribed, appeal to the Commissioner in person."

25 The right of appeal thus given only exists where claims in the application for a patent, or some of them, have been twice considered and rejected by the primary examiner. And the question here is, whether any of the claims in the application of the appellant have been twice considered and rejected by the primary examiner, within the sense and meaning of the provisions of the statute? It is not denied, that to constitute a rejection of the claims in the meaning of the statute, the action or decision of the primary examiner must amount, in legal effect, to an adverse decision in respect to the merits of the claim, and be of a character to defeat the right to a patent therefor, unless reversed on appeal. There was no question made in the Patent Office as to the validity or sufficiency of any of the thirteen claims contained in the application to entitle the applicant to a patent therefor; but, because they related to different subjects-matter—one portion of them to process and the other to apparatus—the applicant was required to divide the claim, or, in the language of the primary examiner in his letter to the applicant, the latter was required to cancel *in this case* the apparatus claims, leaving the party to his right to make a separate application for a patent for those claims. There was no definite adverse decision against the claims, or against their patentability. The primary examiner had no power to make such decision without examination of the merits of the claims and twice rejecting them, because of the want of patentability, and this was not done, nor was it intended to be done; and such was the understanding and construction of the proceeding in the Patent Office; the requirement being simply that the application stands as for the process claims, and that the apparatus claims be presented in a separate application. This requirement the applicant refused to comply with, and the question is, whether there was power, under the statutes and the rules of the Patent Office, to make the required division of the claims, and to insist upon the enforcement of it.

26 It must be borne in mind that a patent for a process and a patent for a machine or apparatus with which to effect a given result, are very different things. A process is the mode of treatment of certain materials to produce a certain result; and consists of an act or series of acts performed upon the subject-matter to be transformed and reduced to a different state or thing,—whereas a machine or apparatus is a combination of mechanical elements which may or not be useful in performing the acts which constitute the process. *Cochrane vs. Deener*, 94 U. S., 780, 788; *James vs. Campbell*, 104 U. S., 356, 377. As said in the last mentioned case, a process and a machine for applying the process, are not necessarily one and the same invention. They are generally distinct and different. And this well recognized distinction is provided for in the rules of the Patent Office.

Before referring to the rules of practice bearing upon this ques-

tion, it may be proper that we refer to the sections of the Revised Statutes that confer authority to make such rules.

Section 481, Rev. Stats., provides that "the Commissioner of Patents, under the direction of the Secretary of the Interior, shall superintend or perform all duties respecting the granting and issuing of patents directed by law, and he shall have charge of all books, records, papers, models, machines and other things belonging to the Patent Office." By section 482, it is provided that "the examiners-in-chief shall be persons of competent legal knowledge and scientific ability, whose duty it shall be on the written petition of the appellant to revise and determine upon the *validity of the adverse decisions of the examiners upon applications for patents*, and for reissues of patents, and in interference cases; and, when required by the Commissioner, they shall hear and report upon claims for extensions, and perform such other like duties as he may assign them." And, by section 483, it is provided that "the Commissioner of Patents, subject to the approval of the Secretary of the
27 Interior, may from time to time establish regulations, *not inconsistent with law*, for the conduct of proceedings in the Patent Office."

It is to be observed and borne in mind that the right of appeal given by section 4909 of the Revised Statutes is given in general terms, and only when some of the claims of the applicant have been rejected; that is, as we have shown, have been considered and twice rejected on their merits, as not being patentable for some of the causes designated by the statute. If appeals were allowed in all cases of mere preliminary or interlocutory orders as well as in cases of adverse decisions on the merits of the claims, it is not difficult to see that great delays, expense, and embarrassments would be produced in conducting proceedings in the Patent Office. If appeals would lie in such cases to the examiners-in-chief, they would equally lie to the Commissioner from the examiners-in-chief, and from the Commissioner to this court. That was clearly never intended by Congress in the use of the general terms that appear in the section of the Revised Statutes. Nor has that been the understanding of the officials charged with the administration of the affairs of the Patent Office.

We shall now refer to and recite certain of the rules made to regulate the conduct of the proceedings in that office.

Rule 41 is as follows: "Two or more independent inventions can not be claimed in one application; but where several distinct inventions are dependent upon each other and mutually contribute to produce a single result they may be claimed in one application. *Claims for a machine and its product must be presented in separate applications. Claims for a machine, and the process in the performance of which the machine is used must be presented in separate applications.* Claims for a process and its product may be presented in the same application." And rule 42 provides the mode of proceeding to effect division of claims when proper to be made. That rule provides that "If several inventions, claimed in a single application, be of

such a nature that a single patent may not be issued to cover
28 them, the inventor will be required to limit the description, drawing, and claim of the pending application to whichever invention he may elect. The other inventions may be made the subjects of separate applications, which must conform to the rules applicable to original applications. If the independence of the inventions be clear, *such limitation will be made before any action upon the merits;* otherwise it may be made at any time before final action thereon, in the discretion of the examiner."

Rules 133 and 134 have an important bearing upon the question under consideration. They are intended to regulate appeals that are prosecuted in the Patent Office, and they show under what conditions appeals are allowed, and from what nature of decisions they can be taken.

Rule 133 provides that "every applicant for a patent, any of the claims of whose application have been twice rejected for the same reasons, *upon grounds involving the merits of the invention*, such as lack of invention, novelty or utility, or on the ground of abandonment, public use or sale, inoperativeness of invention, aggregation of elements, incomplete combination of elements, or, when amended, for want of identity with the invention originally disclosed, or because the amendment involves a departure from the invention originally presented; * * * may, upon payment of a fee of $10, appeal from the decision of the primary examiner to the examiners-in-chief." * * *

And rule 134 provides, that "there must have been two rejections of the claims as originally filed, or, if amended in matter of substance, of the amended claims, and *all the claims must have been passed upon, and all preliminary and intermediate questions relating to matters not affecting the merits of the invention settled, before* the case can be appealed to the examiners-in-chief."

We have carefully scrutinized these several rules, and we perceive nothing in them that can, by any fair and reasonable construc-
29 tion, be held to be inconsistent with the provisions of the statute relating to the patent system. If there be no such inconsistency, with the express provisions of the statute, the rules are valid and have the force and effect of law, in all matters to which they relate. They are certainly not to be declared invalid upon any strained or doubtful construction, but only for such conflict or inconsistency with the statute law upon the subject as shall be made plainly to appear. These rules with many others, forming a system of practical procedure for the Patent Office, were adopted by able and experienced patent lawyers who occupied the position of Commissioner of Patents, and they have been in force for many years, and the practice of the office has been made to conform to them. To support at this late day the contention of the appellant, and declare these rules in any material respect invalid, upon the theory that they restrict the right of appeal, would be attended with very serious consequences to the Patent Office, indeed to the public. An established practice, such as has obtained under these rules,

ought not to be disturbed by the courts, except upon the clearest principle of right and necessity. The rule authorising division of claims to be made is one of grest importance in conducting the business of the office. Without such rule it would be difficult, if not impossible, to make and maintain such essential classification of the subjects of claims as would enable the office to observe and carry out the policy of the law, in making full and complete examinations as to the novelty and priority of every claim that is presented for a patent. This is a matter in which the public is greatly interested. It may be, some times, difficult to determine upon a proper division among claims presented in a single application. But, as said by the Supreme Court, in the case of *Bennett vs. Fowler*, 8 Wall. 445, "It is difficult, perhaps impossible, to lay down any general rule by which to determine when a given invention or improvements shall be embraced in one, two, or more patents. Some discretion must necessarily be left on this subject to the head of the office. It is often a nice and perplexing question."

30 This case of *Bennett vs. Fowler* recognizes the right of division of claims and the power over the subject as being in the Commissioner as head of the office. Being a matter of form and procedure the power over it is vested in the Commissioner as belonging to his supervisory power given him by the statute. His determination of such question under the rule, is final, and not reviewable by any authority in the Patent Office. In all matters involving the validity and patentability of claims and priority of invention, he exercises only an appellate jurisdiction. But in matters of practice and procedure not involving the merits and final rejection of claims, he acts in his supervisory capacity as head of the office. There must be some limit to the right of a party to have joined several and different claims in a single patent; and that being so, who is to decide the question when the division should or should not be made? The Commissioner as the head of the office is intrusted with the ultimate exercise of that power under the rules, and, it would seem, most appropriately so. The decision of the question of division in some cases may be difficult to make, it is true, but still the question must be decided as a preliminary one and as one of procedure merely. And as a regulation of such procedure rule 45 provides that "upon receiving a petition stating concisely and clearly any proper question which has been twice acted upon by the examiner, and which *does not involve the merits of the invention claimed*, and also stating the facts involved and the point or points to be reviewed, an order will be made fixing a time for hearing such petition by the Commissioner, and directing the examiner to furnish a written statement of the grounds of his decision upon the matters averred in such petition within &c. The examiner shall, at the time of making such statement, furnish a copy thereof to the petitioner: No fee is required for such petition."

It was under this rule that the appellant petitioned the Commissioner to review and reverse the action of the primary examiner

in requiring a division of the claims. And the decision of
31 the Commissioner, upon that application, was final and conclusive upon the subject, as to the application for the patent then pending. The appellant was bound to make the division as required, and the decision of the Commissioner approving the action of the examiner cannot be reversed and the Commissioner required to direct the examiner to answer and forward the appeal to the examiners-in-chief as prayed by the appellant. There is no ground shown for a mandamus, and the order appealed from, dismissing the petition therefor, must be affirmed; and it is so ordered. *Judg't affirmed.*

32 TUESDAY, *May 5th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. Steinmetz, Appellant,
vs.
FREDERICK I. ALLEN, Commissioner of Patents.
} No. 1272, April Term, 1903.

Appeal from the supreme court of the District of Columbia.

This cause came on to be heard on the transcript of the record from the supreme court of the District of Columbia, and was argued by counsel. On consideration whereof, it is now here ordered and adjudged by this court that the judgment of the said supreme court, in this cause be, and the same is hereby, affirmed with costs.

Per Mr. CHIEF JUSTICE ALVEY.

May 5, 1903.

33 In the Court of Appeals of the District of Columbia, April Term, 1903.

U. S. *ex Rel.* CHARLES P. STEINMETZ
vs.
FREDERICK I. ALLEN, Commissioner of Patents.
} No1. 272. No. 12, Special Calendar.

Now comes the plaintiff-relator and petitions this honorable court to grant to him a writ of error in the above entitled case to remove the same to the Supreme Court of the United States, and, for cause shows, that the said case is one wherein is drawn in question an authority exercised under the United States and the validity of such authority, and assigns the following as errors committed by this honorable court:

First. This court erred in affirming the judgment of the supreme court of the District of Columbia.

Second. This court erred in affirming the judgment of the supreme court of the District of Columbia in dismissing the relator's petition for a mandamus.

Third. This court erred in affirming the judgment of the supreme court of the District of Columbia in rendering judgment in said case for the defendant.

Fourth. This court erred in not reversing the judgment of the supreme court of the District of Columbia and in not sustaining the relator's motion for a writ of mandamus notwithstanding the defendant's return.

Fifth. This court erred in not reversing the judgment of the supreme court of the District of Columbia and in not directing the said supreme court of the District of Columbia to issue the writ of mandamus to the defendant, commanding him to direct the primary examiner to forward the relator's appeal to the board of examiners-in-chief with a proper answer and statement as required by
34 the rules of practice of the United States Patent Office, to the end that the adverse decision of the primary examiner upon, and the second rejection by said primary examiner of claims 7, 8, 9, 10, 11, 12 and 13, of the relator's application, complained of, might be revised and determined by the board of examiners-in-chief, according to law.

Sixth. That this court erred in holding that the relator did not have a clear right of appeal to the board of examiners-in-chief from the said decision of the primary examiner of the 16th day of August, 1900, complained of.

Seventh. That this court erred in holding that the said decision of the primary examiner complained of did not constitute an adverse decision upon and a second rejection of any of the claims of relator's application for patent under sections 482 and 4909 of the Revised Statutes of the United States.

Eighth. That this court erred in holding that rule 133 of the Rules of Practice of the United States Patent Office regulating appeals is valid and not inconsistent with law.

Ninth. That this court erred in holding that the establishment of rule 133 of the Rules of Practice of the United States Patent Office by the Commissioner of Patents is a valid exercise of an authority under the United States.

Tenth. That this court erred in holding that the defendant exercised a valid authority under the United States when he instructed and directed the primary examiner not to answer and forward to the examiners-in-chief the relator's appeal to said examiners-in-chief.

Eleventh. That this court erred in holding that the requirement of division of relator's application was a matter resting entirely in the discretion of the Commissioner of Patents and not reviewable on appeal by the various statutory appellate tribunals, including the examiners-in-chief, the Commissioner of Patents and the Court of Appeals of the District of Columbia.

35 Wherefore, plaintiff-relator prays that his assignment of errors be filed in this court, that a writ of error to remove the case to the Supreme Court of the United States be granted and that the judgment of this court may be reversed that a writ of

mandamus may issue as prayed for in the petition and that the plaintiff in error may have all proper relief.

ALBERT G. DAVIS,
MELVILLE CHURCH,
Attorneys for Plaintiff in Error.

June 25, 1903.

(Endorsed:) In the Court of Appeals of the District of Columbia. U. S. *ex rel.* Steinmetz *vs.* F. I. Allen, Com'r of Patents. No. 1272. No. 12 special calendar. Petition for writ of error & assignments of error. Court of Appeals, District of Columbia. Filed Jun- 25, 1903. Robert Willett, clerk.

36 THURSDAY, *June 25th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

The petition for writ of error to remove the above entitled cause to the Supreme Court of the United States was submitted to the consideration of the court by Mr. Melville Church in support of petition.

FRIDAY, *June 26th, A. D.* 1903.

UNITED STATES *ex Relatione* CHARLES P. STEINMETZ, Appellant, *vs.* FREDERICK I. ALLEN, Commissioner of Patents. } No. 1272.

On consideration of the appellant's petition for a writ of error to remove this cause to the Supreme Court of the United States, it is by the court this day ordered that said writ issue as prayed, and bond for costs is fixed at the sum of two hundred and fifty dollars.

37 UNITED STATES OF AMERICA, *ss:*

The President of the United States to the honorable the justices of the Court of Appeals of the District of Columbia, Greeting:

Because, in the record and proceedings, as also in the rendition of the judgment of a plea which is in the said Court of Appeals before you, or some of you, between United States, *ex relatione*, Charles P. Steinmetz, appellant, and Frederick I. Allen, Commissioner of Patents, appellee, a manifest error hath happened, to the great damage of the said appellant, as by his complaint appears. We being

willing that error, if any hath been, should be duly corrected, and full and speedy justice done to the parties aforesaid in this behalf, do command you, if judgment be therein given, that then under your seal, distinctly and openly, you send the record and proceedings aforesaid, with all things concerning the same to the Supreme Court of the United States, together with this writ, so that you have the same in the said Supreme Court at Washington within 30 days from the date hereof, that the record and proceedings aforesaid being inspected, the said Supreme Court may cause further to be done therein to correct that error, what of right, and according to the laws and customs of the United States should be done.

Seal Court of Appeals, District of Columbia.

Witness the Honorable Melville W. Fuller, Chief Justice of the United States, the 26th day of June, in the year of our Lord one thousand nine hundred and three.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

38 Court of Appeals, District of Columbia.

UNITED STATES *ex Rel.* CHARLES P. Steinmetz
vs.
FREDERICK I. ALLEN, Commissioner of Patents.

No. 1272. No. 12, Special Calendar.

Know all men by these presents, that we *Charles P. Steinmetz*, as principal, and *National Surety Company*, as surety, are held and firmly bound unto Frederick I. Allen, in the full and just sum of *$250*, to be paid to the said Frederick I. Allen, his certain attorney, executors, administrators or assigns; to which payment, well and truly to be made, we bind ourselves, our heirs, executors and administrators, jointly and severally, by these presents.

Sealed with our seals and dated this 3rd day of July, in the year of our Lord one thousand nine hundred and three.

Whereas, lately at a Court of Appeals of the District of Columbia in a suit depending in said court, between the United States upon the relation of said Charles P. Steinmetz, as appellant, and the said Frederick I. Allen, as appellee, a judgment was rendered against the said United States and the said relator, and the said relator in the name of the United States having obtained a writ of error and filed a copy thereof in the clerk's office of the said court to reverse the judgment in the aforesaid suit, and a citation directed to the said Frederick I. Allen, citing and admonishing him to be and appear at a Supreme Court of the United States, to be holden at Washington, within thirty days from the date thereof;

Now, the condition of the above obligation is such, that if the said Charles P. Steinmetz, in the name of the United States, or otherwise,

shall prosecute said writ of error to effect, and answer all costs if he fail to make his plea good, then the above obligation to be
39 void; else to remain in full force and virtue.

CHARLES P. STEINMETZ.

[Seal of National Surety Company.]

NATIONAL SURETY COMPANY,
By WILLIAM J. GRIFFIN,
2nd Vice President.

Attest: WM. R. WORRALL, *Res. Ass't Secretary.*

Approved
JOHN M. COIT,
Counsel for Com'r of Patents.

The foregoing bond approved,
R. H. ALVEY,
Chief Justice.

40 *Affidavit, Acknowledgment, and Justification by Guarantee or Surety Company.*

STATE OF NEW YORK, } ss:
County of New York, }

On this 3rd day of July one thousand nine hundred and three, before me personally came William J. Griffin, known to me to be the 2nd vice president of the National Surety Company, the corporation described in and which executed the within and foregoing bond of Charles P. Steinmetz, as a surety thereon, and who, being by me duly sworn, did depose and say that he resides in the city of New York, State of New York; that he is the 2nd vice president of said company, and knows the corporate seal thereof; that the said National Surety Company is duly and legally incorporated under the laws of the State of New York; that said company has complied with the provisions of the act of Congress of August 13th, 1894; that the seal affixed to the within bond of Charles P. Steinmetz is the corporate seal of said company, and was thereto affixed by order and authority of the board of directors of said company, and that he signed his name thereto by like order and authority as 2nd vice president of said company, and that he is acquainted with Wm. R. Worrall and knows him to be the res. ass't secretary of said company; and that the signature of said Wm. R. Worrall subscribed to said bond is the genuine handwriting of said Wm. R. Worrall, and was thereto subscribed by order and authority of said board of directors, and in the presence of said deponent; and that the assets of said company, unencumbered and liable to execu-

tion exceed its claims, debts and liabilities of every nature whatsoever, by more that the sum of one million dollars.

Jas. H. Ellsworth is our agent to acknowledge service in the judicial district of the District of Columbia.

(Deponent's signature:) WILLIAM J. GRIFFIN.

Sworn to, acknowledged before me, and subscribed in my presence this third day of July, 1903.

(Officer's signature, description and seal:)

[NOTARIAL SEAL.] JAMES FAWKNER,
Notary Public, No. 106, *for Kings County.*

Certificate filed in New York, Queens, Richmond, and Westchester counties.

Form 4.

STATE OF NEW YORK, *County of New York,* } ss:

I, Thomas L. Hamilton, clerk of the county of New York, and also clerk of the supreme court for the said county, the same being a court of record, do hereby certify that James Fawkner has filed in the clerk's office of the county of New York, a certified copy of his appointment and qualification as notary public for the county of Kings with his autograph signature, and was at the time of taking the annexed deposition, duly authorized to take the same, and that I am well acquainted with the handwriting of said notary public, and believe that the signature to the annexed certificate is genuine.

In testimony whereof, I have hereunto set my hand and affixed the seal of the said court and county, the 3d day of July, 1903.

[SEAL.] THOS. L. HAMILTON, *Clerk.*

[Endorsed:] No. 1272. Court of Appeals, District of Columbia. U. S. *ex rel.* Charles P. Steinmetz *vs.* Frederick I. Allen, Commissioner of Patents. Bond on writ of error S. C. U. S. Court of Appeals, District of Columbia. Filed Jul- 21, 1903. Robert Willett, clerk.

41 UNITED STATES OF AMERICA, ss:

To Frederick I. Allen, Commissioner of Patents, Greeting:

You are hereby cited and admonished to be and appear at a Supreme Court of the United States, at Washington, within 30 days from the date hereof, pursuant to a writ of error, filed in the clerk's office of the Court of Appeals of the District of Columbia, wherein United States *ex rel.* Charles P. Steinmetz is plaintiff in error, and you are defendant in error, to show cause, if any there be

why the judgment rendered against the said plaintiff in error as in the said writ of error mentioned, should not be corrected, and why speedy justice should not be done to the parties in that behalf.

Witness, the Honorable R. H. Alvey, Chief Justice of the Court of Appeals of District of Columbia, this 21st day of July, in the year of your Lord one thousand nine hundred and three.

R. H. ALVEY,
Chief Justice of the Court of Appeals of the District of Columbia.

Service admitted this 21st day of July 1903.

JOHN M. COIT,
For Frederick I. Allen, Commissioner of Patents.

42 Court of Appeals of the District of Columbia.

I, Robert Willett, clerk of the Court of Appeals of the District of Columbia, do hereby certify that the foregoing printed and typewritten pages, numbered from 1 to 41 inclusive, contain a true copy of the transcript of record and proceedings of said Court of Appeals in the case of United States *ex relatione* Charles P. Steinmetz, appellant *vs.* Frederick I. Allen, Commissioner of Patents No. 1272, April term, 1903, as the same remain upon the files and records of said Court of Appeals.

Seal Court of Appeals, District of Columbia.

In testimony whereof I hereunto subscribe my name and affix the seal of said Court of Appeals, at the city of Washington, this 21st day of July A. D. 1903.

ROBERT WILLETT,
Clerk of the Court of Appeals of the District of Columbia.

Endorsed on cover: File No. 19,034. District of Columbia Court of Appeals. Term No. 383. The United States *ex relatione* Charles P. Steinmetz, plaintiff in error, *vs.* Frederick I. Allen, Commissioner of Patents. Filed July 29th, 1903.